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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/809,638

03/14/2001

Mary Faris

G&C 129.35-US-01

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06/06/2002

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EXAMINER

BRUMBACK, BRENDA G

ART UNIT

PAPER NUMBER

1642

8

DATE MAILED: 06/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/809,638

Applicant(s)

FARIS ET AL.

Examiner

Brenda G. Brumback

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-55 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-13, 14 (in part), 15 (in part), 17 and 23 (in part), drawn to an isolated 125P5C8-related protein comprising an amino acid sequence of SEQ ID NO:2, classified in class 530, subclass 350.
- II. Claims 1, 14 (in part), 15 (in part), 16, and 23 (in part), drawn to an isolated 125P5C8-related protein encoded by a nucleic acid comprising a polynucleotide sequence of SEQ ID NO:1, classified in class 530, subclass 350.
- III. Claims 1 and 14 (in part) drawn to an isolated 125P5C8-related protein encoded by a cDNA, classified in class 530, subclass 350.
- IV. 15 Claims 18-21 and 49, drawn to a polynucleotide encoding a 125P5C8-related protein, classified in class 536, subclass 350.
- V. Claims 21 (in part) and 22, drawn to a method of making a 125P5C8-related protein, classified in class 435, subclass 69.1.
- VI. Claims 24-33, 35, 36, and 47, drawn to antibodies that bind a 125P5C8-related protein, classified in class 530, subclass 388.1.
- VII. Claim 34, drawn to a transgenic animal, classified in class 800, subclass 10.
- VIII. Claim 37, drawn to a vector comprising a polynucleotide that encodes an antibody which binds a 125P5C8-related protein, classified in class 536, subclass 23.53.
- IX. Claim 38 (in part), drawn to an assay for detecting a 125P5C8-related protein comprising contacting a sample with an antibody, classified in class 435, subclass 7.1.

- X. Claim 39, drawn to an assay for detecting a 125P5C8-related protein comprising evaluating a sample in the presence of the protein, classified in class 4.5, subclass 7.93, for example.
- XI. Claims 38 (in part), 40, and 41, drawn to an assay for detecting a 125P5C8-related protein comprising contacting a sample with a polynucleotide probe, classified in class 435, subclass 6.
- XII. Claims 42-44, drawn to a method of monitoring 125P5C8 gene products, classified in class 435, subclass 6, for example.
- XIII. Claims 45 and 46, drawn to a pharmaceutical composition comprising a substance which modulates the status of a cell expressing 125P5C8, classified in class 530, subclass 350.
- XIV. Claim 48, drawn to a pharmaceutical composition comprising a polynucleotide encoding an antibody that binds to a 125P5C8-related protein, classified in class 514, subclass 44.
- XV. Claim 50, drawn to a pharmaceutical composition comprising an antisense polynucleotide, classified in class 514, subclass 44.
- XVI. Claim 51, drawn to a pharmaceutical composition comprising a ribozyme, classified in class 424, subclass 94.1.
- XVII. Claim 52, drawn to a method of treating a patient comprising administering a vector comprising a polynucleotide encoding an antibody that binds detecting a 125P5C8-related protein, classified in class 514, subclass 44.
- XVIII. Claim 53, drawn to a method of inhibiting cancer, classified in class 424, subclass 185.1.
- XIX. Claims 1 and 54, drawn to a method of generating an immune response, classified in class 424, subclass 185.1
- XX. Claims 24 and 55, drawn to a method of delivering a cytotoxic agent, classified in class 424, subclass 130.1.

Art Unit: 1642

The inventions are distinct, each from the other because of the following reasons:

Inventions I and X and XIX; IV and XI; VI and IX and XX; and XIV and XVII are related as products and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the proteins of Group I can be used in the materially different process of affinity purification of antibodies; the polynucleotides of Group IV can be used in the materially different processes of protein production, gene therapy, and diagnostic testing; the antibodies of Group VI can be used in the materially different process of affinity purification of proteins; and the polynucleotides of Group XIV can be used in the materially different processes of antibody production and diagnostic testing.

The products of Groups I, II, III, IV, VI, VII, VIII, XIII, XIV, XV, and XVI have different structures, different chemical compositions, and different immunological properties.

The methods of Groups V, IX, X, XI, XII, XVII, XVIII, XI, and XX are for different purposes, have different method steps, and have different outcomes.


Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and/or their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Art Unit: 1642

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Brumback whose telephone number is (703) 306-3220. If the examiner can not be reached, inquiries can be directed to Supervisory Patent Examiner Anthony Caputa whose telephone number is (703) 308-3995. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Examiner Brenda Brumback, Art Unit 1642 and should be marked "OFFICIAL" for entry into prosecution history or "DRAFT" for consideration by the examiner without entry. The Official FAX telephone number is (703) 872-9306 and the After Final FAX telephone number is (703) 872-9307. FAX machines will be available to receive transmissions 24 hours a day. In compliance with 1096 OG 30, the filing date accorded to each OFFICIAL fax transmission will be determined by the FAX machine's stamped date found on the last page of the transmission, unless that date is a Saturday, Sunday or Federal Holiday with the District of Columbia, in which case the OFFICIAL date of receipt will be the next business day.


Brenda Brumback
Patent Examiner